



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,506	07/02/2003	Motoaki Aoyama	KOT-0078	3507

23413 7590 11/27/2007
CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER

NGUYEN, ALLEN H

ART UNIT	PAPER NUMBER
----------	--------------

2625

MAIL DATE	DELIVERY MODE
-----------	---------------

11/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/612,506

Applicant(s)

AOYAMA ET AL.

Examiner

Allen H. Nguyen

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is also required under 35 U.S.C.

121:

I. Claims 1- 15 drawn to an image forming apparatus, classified in class 347, subclass 3.

II. Claims 19-21 drawn to a system comprising image forming apparatus communicating with a computer, classified in class 358, subclass 1.15.

III. Claims 22-42 drawn to a computer, classified in class 709, subclass 5.

2. Inventions (III) and (I, II) are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination (II) as claimed does not require the particulars of the subcombination (III) as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant cases:

The combination (a system) as claimed does not require the particulars of the subcombination (I) as claimed for patentability because: The specific in the subcombination claim 1 recites, for example, a finish setting establishing section to conduct establish a set of finish setting to be applied to said print product based on a result made by said determining section is not in combination claim 19. The subcombination printer has separate utility such as printing for a camera.

The combination (a system) as claimed does not require the particulars of the subcombination (III) as claimed for patentability because: The specific in the subcombination claim 22 recites, for example, "an acquiring section to acquire image data and an address of an image forming apparatus" is not found in claim 19. The subcombination computer has separate utility such as displaying image for a user.

3. Invention I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination has separate utility as previously discussed. See MPEP 806.05(d).

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Invention (I, II) also contains claims directed to patentably distinct species.

(I, II) a. Species directed to the processing content can contain change of finishing information, when the receiving apparatus can not process the instruction, discloses on page 20, lines 4-5.

(I, II) b. Species directed to the processing content can contain stop of processing or cancellation of processing, when the receiving apparatus can not process the instruction, discloses on page 20, lines 5-6.

(I, II) c. Species directed to the electronic-mail receiving apparatus notifies the sender when the receiving apparatus can not process the instruction discloses on page 19, lines 21-22.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious burden and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the invention has acquired a separate status in the art in view of their different classification;

(b) the inventions have acquired a separate status in the art due to their divergent subject matter;

(c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 112, first paragraph.

6. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the restriction may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

7. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out the supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

8. Shall applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is

Application/Control Number:
10/612,506
Art Unit: 2625

Page 6

the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence of admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

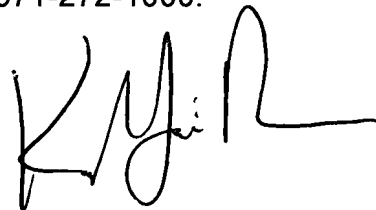
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen H. Nguyen whose telephone number is 571-270-1229. The examiner can normally be reached on M-F from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571)-272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AN

11/26/2007



KING Y. POON
SUPERVISORY PATENT EXAMINER